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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,041	09/25/2003	Jerome Sohier	05032-00032	8052
22910	7590	08/30/2006	EXAMINER	
BANNER & WITCOFF, LTD. 28 STATE STREET 28th FLOOR BOSTON, MA 02109-9601			YOON, TAE H	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 08/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/673,041

Applicant(s)

SOHIER ET AL.

Examiner

Tae H. Yoon

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 August 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7, 10, 11, 13-17, 19 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10, 11, 13-17, 19 and 21-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Specification is objected since a section, Brief Description of The Drawings, is missing.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 13-17, 19 and 21-26 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mahmood et al (US 6,656,489).

Mahmood et al teach a scaffold for tissue engineering cartilage comprising a layer of ceramic and a layer of PEG/PBT copolyester having bioactive agents in abstract. The instant weight average of polyalkylene glycol and said copolyester is taught at col. 3. Porous structure is taught at col. 4, lines 31-39 and spraying of copolyester solution is also taught at col. 6, lines 6-9.

Thus, the invention lacks novelty.

Claims 1-7, 10, 11, 13-17, 19 and 21-26 are rejected, under 35 U.S.C. 103(a) as obvious over Mahmood et al (US 6,656,489) and EP 0 830 859 A2.

The instant invention further recites particular biologically active agents such as proteins over Mahmood et al, but those are well known in the art as taught by EP, page 3, lines 14-16.

It would have been obvious to one skilled in the art at the time of invention to utilize the biologically active agents of EP in the copolyester coating composition of Mahmood et al since Mahmood et al teach employing biologically active agents.

Claims 1-7, 10, 13-17, 19 and 21-26 are rejected under 35 U.S.C. 103(a) as obvious over Bakker et al (US 2002/0095213 A1) in view of Steinke et al (US2003/0199969 A1), Wallace et al (US 6,280,457) and Tormala et al (US 2003/0206928 A1).

Bakker et al teach polymeric medical devices ([0075]) coated with the instant copolymer of PEGT and PBT (examples 1-6). Porous coating is also taught in [0092], and the use of a pore-forming agent is taught in [0072].

The instant invention further recites different surfaces such as metals, metal alloys, ceramics and glasses, the use of a biologically active agent and pins and screws thereof over Bakker et al.

However, medical devices made of the instant metals, metal alloys, ceramics and glasses are well known as taught by Steinke et al ([0019]) and Wallace et al (col. 3, lines 57-59). Wallace et al further teach a medical device coated with a polymer in abstract and the use of biologically active agents at col. 3, lines 60-62. Said pins and screws are well known medical devices as taught by Tormala et al ([0049]).

It would have been obvious to one skilled in the art at the time of invention to utilize art well known biologically active agent of Wallace et al in the polyester coating composition of

Bakker et al and to coat medical devices made of the instant metals, metal alloys or ceramics taught by Steinke et al and Wallace et al since medical devices made of the instant metals, metal alloys and ceramics are well known in the art and since coating of a medical device with a polymeric coating composition containing biologically active agents in order to prevent infections or improve cell growth is a routine practice in the art as taught by Wallace et al and since Bakker et al teach coating medical devices with the polyester, and further to pins or screws as medical devices in Bakker et al since the instant pins and screws are well known medical devices as taught by Tormala et al absent showing otherwise. Also, cleaning of the surface of medical device before coating would be a *prima facie* obviousness since it would provide a better adhesion of coating.

Claims 1-7, 10, 11, 13-17, 19 and 21-26 are rejected under 35 U.S.C. 103(a) as obvious over Bakker et al (US 2002/0095213 A1) in view of Steinke et al (US2003/0199969 A1), Wallace et al (US 6,280,457) and Tormala et al (US 2003/0206928 A1), and further in view of EP 0 830 859 A2.


The instant invention further recites particular biologically active agents such as proteins over Bakker et al, Steinke et al, Wallace et al and Tormala et al, but those are well known in the art as taught by EP, page 3, lines 14-16.

It would have been obvious to one skilled in the art at the time of invention to utilize the biologically active agents of EP in the copolyester coating composition of Bakker et al in coating medical devices of Steinke et al, Wallace et al and Tormala et al since Wallace et al teach the use of biologically active agents et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Tae H Yoon  
Primary Examiner  
Art Unit 1714

THY/August 14, 2006